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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,704	06/07/2001	James S. Mrozinski	55870US002	9401

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EXAMINER

TRAN, SUSAN T

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 11/12/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/876,704	Applicant(s) MROZINSKI ET AL.	
	Examiner Susan T. Tran	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-10, 12-15, 18-33 and 35-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10, 12-15, 18-33, 35-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of applicant's Amendment filed 06/23/03 (not enter), Request for Continued Examination, Request for Extension of Time, and Preliminary Amendment filed 09/15/03.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/15/03 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-10, 12-15, 18-33, 35-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,638,611 ('663). Although the conflicting claims are not identical, they are not patentably distinct from each other because '663 claims an oil absorbing wipe suitable for wiping a users skin comprising oil absorbing porous film of a thermoplastic material having a transparency of less than 65% wherein said porous film changes transparency when loaded with oil. The skin cleansing agent is found in claim 12. The interstitial volume is found in claim 13. The void content is found in claim 14. The filler is found in claims 15-17. The average particle size of the porous film voids is found in claim 18. The melt-blown web of thermoplastic fibers is found in claim 20. Polyolefin microfiber is found in claim 21. Therefore, those of ordinary skill would expect a similar oil absorbing wipe suitable for wiping a users skin from the teaching of the instant invention given the claims of US '663. There are no unusual and/or unexpected results, which would rebut prima facie obviousness. As such, the instant claims would have been obvious given the claims of US '663, which set out a similar wipe using the same materials and ingredients.

Claims 1, 4-10, 12-15, 18-33, 35-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,645,611 ('664). Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1, 4-10, 12-15, 18-33, 35-72 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the

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claims of copending Application No. 10/001,094. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 2, 10, 25 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 22 and 23 are rejected for depending in the subject matter of a cancelled claim.

Claim 25 is indefinite in the use of the phrase "30 percentage points". What are percentage points?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-10, 13-15, 18-25, 28-33, 37, 38, 41-55, 57-66, and 69-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. WO 99/29220.

Kondo teaches oil absorbing sheet comprising porous plastic film sheet, e.g., polypropylene, polyethylene, polybutylene, ethylene-propylene block copolymer, or poly-4-methylpentene; and coating, including about 20-60% fillers, e.g., mineral oils, and other additives (pages 4, and 6-7). The porous film sheet has interstitial volume in the range of 0.0001-0.005 cm³, void content in the range of 5-50%, the thickness in the range of 5-200µm, and oil absorption per unit of up to 3.78 mg/cm² (pages 5, 8, and 14-22). Other additives in the coating include surface- active agent and hydrophilic polymer, e.g., polyvinyl alcohol, and polyethylene glycol; and wherein the coating can be on a single or both surfaces of the film (pages 9-11). Kondo does not specifically teach the transparency of less than 65 percent. However, Kondo teaches excellent transparency, notable transparency enabling easy confirmation of oil absorption (page 8 and examples). Accordingly, absent showing evidence on the contrary, the transparency taught by Kondo is at least the same as the claimed transparency. Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art to, by routine experimentation obtain the claimed invention because Kondo recognizes the same results desired by the applicant, e.g., excellent absorption of the skin oil, notable transparency, suitable to absorb large amount of sweat and skin oil on the face (page 1).

Claims 12, 26, 27, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al., and Sugiyama et al. US 4,643,939.

Kondo is silent as to the teaching of polyolefin microfiber and salicylic acid. However, it is the position of the examiner that polyolefin is of the same polymer group as polypropylene, and therefore, it would have been obvious for one of ordinary skill in the art to, by routine experimentation select a suitable thermoplastic film and a suitable organic acid with the expectation of at least similar result, because Kondo teaches thermoplastic film material including polypropylene microfiber; filler, such as organic and inorganic acid.

Sugiyama teaches oil-absorbing tissue made of plant fiber, or mixture of plant fiber and synthetic resin fiber (column 2, lines 30-38). The sheet is coated with additives, such as salicylic acid (column 2, lines 39-68). Thus, it would have been obvious for one of ordinary skill in the art to modify Kondo's oil-absorbing sheet with the plant fiber in view of Sugiyama with the expectation of at least similar result, because the references teach the advantageous results in the use of oil-absorbing sheet. The expected result would be oil-absorbing sheet having excellent absorption of the skin oil, and notable transparency to enable easy confirmation of oil absorption and toughness.

Claims 35, 36, 39, 40, 67, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al.

Kondo is silent as to the teaching of the average pore size and the "Hand" of the sheet. However, absent showing evidence on the contrary, it is the position of the examiner that the oil absorbing sheet taught by Kondo would have at least similar pore size and "Hand" weight as the claimed pore size, because, Kondo uses the same

thermoplastic film having the same physical properties, e.g., void volume, interstitial volume, and thickness.

Response to Arguments

Applicant's arguments filed 06/23/03 have been fully considered but they are not persuasive.

Applicant argues that Kondo does not teach adding any additional additive into that coating. Applicant further alleges that the additives described at page 4 lines 6-7, are the additives in the porous film material not additives to a coating on the porous film material. Although the examiner agreed with the argument, there are no unusual and/or unexpected results of the specific location of the additives over the teaching of Kondo. It is noted that additives, namely the skin modifying comprises a wide range of components, including fillers, abrasive, absorbents, binders, buffering agents, bulking agents, so on and so forth (specification, pages 14-15). Thus, it is the position of the examiner that such wide range of components would permit one of ordinary skill in the art to, by routine experimentation select one of the components to combine with the coating. Fillers, binders, or salicylic acid is nothing unexpected/unusual to cosmetic prior art, especially skin care composition.

Applicant argues that the "additives" described at pages 9-10 are actually not additives, but rather alternative suggested coatings to place on one side of the oil absorbing wipe described in Kondo. In response to the applicant's argument, Kondo is relied upon for the teachings within his four-wall patent. The test for obviousness is not

that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the teachings of the references would have suggested to those of ordinary skill in the art to by routine experimentation optimize the teachings within the four-wall patent. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that Kondo does not teach the use of a specific surface coating on one face of an oil absorbing porous. Contrary to the applicant's argument, applicant claims recites "coating on *at least a portion of at least one face*". Accordingly, such language (*at least one face*) allows coating on more than one face.

Pertinent Arts

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hotchkiss et al., Girardot, and Page are cited as being of interest for the teachings of oil absorbing substrate containing active agent, moisturizing agent, or medicament.

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE
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